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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/828,906

04/21/2004

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EXAMINER

FISHER, ABIGAIL L

ART UNIT

PAPER NUMBER

1616

NOTIFICATION DATE

DELIVERY MODE

01/13/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentgroupus@unilever.com

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/828,906 | <b>Applicant(s)</b><br>ZHANG ET AL. |  |
|                              | <b>Examiner</b><br>ABIGAIL FISHER    | <b>Art Unit</b><br>1616             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on February 18 2010 has been entered.

Receipt of Amendments/Remarks filed on February 28 2010 is acknowledged. Claims 3 and 7-9 were/stand cancelled. Claim 1 was amended. Claim 13 was added. Claims 1-2, 4-6 and 10-13 are pending.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed February 18 2010 is insufficient to overcome the rejection of claims 1-2, 4-6 and 10-13 based upon newly cited art . The declaration was submitted to show that the claimed conjugated linoleic acids (CLA) are not fragrances. While the examiner acknowledges the declaration which establishes that CLA have low odor, the newly cited art does not rely on the notion that the CLA are fragrance compounds. Therefore, this declaration is insufficient to overcome the references cited in this Office action.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-2, 4-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodrigues et al. (USPGPUB No. 20040266921, cited in the Office action mailed on 12/19/07) in view of Alaluf et al. (US Patent No. 6287553).**

### **Applicant Claims**

The instant application claims a composition comprising a conjugated linoleic acid and a substituted urea.

### **Determination of the Scope and Content of the Prior Art (MPEP §2141.01)**

Rodrigues et al. is directed to use of hydroxyalkyl urea in aqueous-based polymer compositions to maintain hydration of said composition. Preferred hydroxyalkyl urea compounds are those derived from urea and comprise only a single urea group, at least one hydroxy group, and at least two carbon atoms between the urea group and the hydroxyl group (paragraph 0016). Preferred hydroxyl urea compounds include N-2-hydroxyethyl urea (paragraph 0020, and the conditioner example). The compositions may be formulated with adjuvants. Adjuvants that are useful include lubricants, medications. These adjuvants are utilized in amount from 1 to 10,000 parts based on 100 parts of polymer (paragraph 0035). The hydroxyalkyl urea is used in 0.01 to 50 wt% based on the weight of hydroxyalkyl urea to polymer solids (paragraph 0036). Examples of the formulations include shampoo, conditioner, and shower gels. The examples include water, which is a cosmetically acceptable carrier.

### **Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)**

While Rodrigues et al. teach the addition of adjuvants. Rodrigues et al. does not teach the adjuvant is a conjugated linoleic acid. However, this deficiency is cured by Alaluf et al.

Alaluf et al. is directed to skin care compositions. The compositions are topical for treating skin conditions such as wrinkling, sagging, photo damage, sensitive skin, dry skin, flaky skin, red skin, irritated skin, itchy skin and age spots comprising applying conjugated linoleic acid (CLA) in a dermatologically acceptable carrier (claims 1 and 3). The composition comprises 0.00001 to 50% by weight of the conjugated linoleic acid (claim 2). The compositions are taught as promoting smooth and supple skin with improved elasticity and reduced or delayed appearance of wrinkles and aged skin with improved skin color (column 2, lines 26-38).

***Finding of Prima Facie Obviousness Rationale and Motivation  
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Rodrigues et al. and Alaluf et al. and utilize conjugated linoleic acids in the composition of the Rodrigues et al. One of ordinary skill in the art would have been motivated to add conjugated linoleic acids as Rodrigues et al. teach lubricants or medicaments can be added to the composition and Alaluf et al. teaches that conjugated linoleic acid can be utilized to improve the texture, elasticity and appearance of skin. Therefore, one of ordinary skill in the art would have been motivated to add conjugated linoleic acid in the skin contacting compositions of Rodrigues et al. for the advantages taught by Alaluf et al.

Regarding claim 10 of the instant application, Alaluf et al. does not specify specific Iodine Values of the various conjugated linoleic acid compounds. However the compounds of Alaluf et al. are the same as those instantly claimed. Therefore there is a reasonable expectation that these compounds meet the required Iodine Value range as

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set forth in claim 10 of the instant application. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Regarding the claimed amount of urea and unsaturated material, Rodrigues et al. (urea and adjuvant) and Alaluf et al. (CLA) teach overlapping amounts. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Regarding the claimed ratio of urea to unsaturated material, Rodrigues et al. teach overlapping ranges of urea and adjuvant. Additionally, Alaluf et al. teach an overlapping amount of unsaturated material. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

**Claims 1-2, 4-6 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perricone (US Patent No. 6296861) in view of Moller et al. (EP 2703185, cited on PTO Form 1449).**

### **Applicant Claims**

The instant application claims a composition comprising a conjugated linoleic acid and a substituted urea.

### **Determination of the Scope and Content of the Prior Art (MPEP §2141.01)**

Perricone is directed to the treatment of skin damage using conjugated linoleic acid and ascorbyl fatty acid esters. The compositions treat skin damage such as inflammation, eczema, etc. (claim 1). The conjugated linoleic acid is present in an amount from about 1 to about 25% (claim 6). The compositions can comprise at least one other adjunct ingredient (column 5, lines 66-67).

### **Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)**

While Perricone teach the addition of adjuvants, Perricone does not specify utilizing a hydroxyl urea. However, this deficiency is cured by Moller et al.

Moller et al. (utilizing the English Translation) teach cosmetic compositions with skin moisturizers. The compositions comprise hydroxyalkyl-substituted ureas. A specific hydroxy urea claimed is hydroxyethyl urea (claim 4 and page 5, line 12, 22). The products advantageously suitable for retaining and/or restoring the water retention of the skin and thereby keeping the skin soft and flexible (page 4, lines 25-30). The ureas are used in an amount from 1 to 20% by weight (claim 1). The compositions additionally claim customary constituents such as fatty substances (claim 3).

### ***Finding of Prima Facie Obviousness Rationale and Motivation* (MPEP §2142-2143)**

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Perricone and Moller et al. and utilize hydroxyalkyl ureas in the composition of Perricone. One of ordinary skill in the art would have been motivated to add a hydroxyalkyl urea as Perricone teach compositions for the treatment of skin disorders such as eczema (which is a dry skin disorder) and that adjuvants can be utilized and Moller et al. teach that the hydroxyalkyl ureas can be in compositions as skin moisturizers. Therefore, it would have been obvious to one of ordinary skill in the art to utilize skin moisturizers in composition designed to treat dry skin diseases such as eczema. One of ordinary skill in the art would have a reasonable expectation of success as Moller et al. teach utilizing the hydroxyalkyl urea in compositions with fatty substance (CLA is a fatty substance).

Regarding claim 10 of the instant application, Perricone does not specify specific Iodine Values of the various conjugated linoleic acid compounds. However the compounds of Perricone are the same as those instantly claimed. Therefore there is a reasonable expectation that these compounds meet the required Iodine Value range as set forth in claim 10 of the instant application. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

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Regarding the claimed amount of urea and unsaturated material, Perricone (CLA) and Moller et al. (urea) teach overlapping amounts. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. **See MPEP 2144.05 [R-5].**

Regarding the claimed ratio of urea to unsaturated material, Perricone and Moller et al. teach overlapping amounts. "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969).

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher  
Examiner  
Art Unit 1616

AF

/Mina Haghighatian/  
Primary Examiner, Art Unit 1616